

REMARKS

In this Amendment after Final, Applicants propose amending claim 34 to correct a minor informality in the nature of a misspelled word. Applicants submit that the amendment contains no new matter, in accordance with the requirements of 37 C.F.R. § 1.121(f).

Regarding the Office Action:

Claims 1-55 remain pending. In the Final Office Action dated February 9, 2004, the Examiner rejected claims 1-55 under 35 U.S.C. § 103(a) as being unpatentable over *Borodow et al.* (U.S. Publication No. 2002/0101979 A1) ("*Borodow*").

Regarding the Interview:

Applicants wish to thank Examiner Jordan and Examiner Alimenti for allowing Applicants' representatives to discuss the pending claims during a personal interview on April 9, 2004. The substance of the interview is summarized as follows:

Applicants' representatives set forth arguments showing the impropriety of using *Borodow et al.* as a prior art reference because the subject matter relied upon by the Examiner in that reference was not disclosed in its parent application, *Ezerzer et al.* (U.S. Publication No. US 2003/0093533 A1) ("*Ezerzer*"). *Borodow* is a continuation-in-part of *Ezerzer*. The Examiner maintained the rejection and Applicants' representatives requested the rejection based on the *Borodow et al.* reference be withdrawn. This request was denied at this point in the prosecution, due to, according to the Examiners

as they verbally stated, "the requirements of compact prosecution" and since the request was made after final rejection. However, Applicants would like to note that using *Borodow et al.* as a baseline reference as set forth in the Final Office Action is improper and further note that according to MPEP 706.07(d), a Primary Examiner is authorized to withdraw a Final Rejection if found to be premature. Notwithstanding the exigencies of compact prosecution, common fairness to Applicants requires such withdrawal if such rejection is based on faulty grounds. The Examiners further conceded at the Interview that they would no longer rely on *Borodow*, if Applicants were to file a RCE. Since an RCE requires a significant filing fee and may result in a delay in prosecution, Applicants respectfully submit that prosecution in this case may be successfully concluded based on the arguments set forth in this paper – without the need to file an RCE.

***Borodow et al.* is not valid prior art:**

The subject matter disclosed in *Borodow et al.* that the Examiner has relied on is not prior art under 35 U.S.C. §102, and therefore is not available as prior art under 35 U.S.C. § 103(a). see 35 U.S.C. § 103(a). A continuation-in-part(CIP) application contains subject matter from a prior application and may also contain additional matter not disclosed in the prior application. See *Waldemar Link v. Osteonics Corp.*, 32 F.3d 556, 558, 31 U.S.P.Q.2d 1855, 1857 (Fed. Cir.1994). Subject matter that arises for the first time in the CIP application does not receive the benefit of the filing date of the parent application. See *id.* Thus, the decision on the proper priority date - the parent application date or the CIP application date - for subject matter claimed in a CIP

application depends on when that subject matter first appeared in the patent disclosures. To decide this question, a court must examine whether the "disclosure of the application relied upon reasonably convey[s] to the artisan that the inventor had possession at that time of the later claimed subject matter." *Id.* (quoting *1303 *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 865, 26 U.S.P.Q.2d 1767, 1774 (Fed.Cir.1993)).

Specific to the facts of the present application, *Borodow et al.*, filed on July 9, 2001, is a continuation-in-part of application No. 09/638,274, to *Ezerzer et al.* filed August 14, 2000. The portions of the disclosure of *Borodow et al.* that the Examiner relied on for making the 103(a) rejection, were not disclosed in the parent application to *Ezerzer et al.*, and consequently do not receive the benefit of the parent application filing date. Those portions are thus entitled only to an effective date of July 9, 2001, which is after the Applicants' filing date of March 30, 2001. The Examiner, on page 6 of the Office Action, even acknowledges that "[w]hile *Borodow* discloses a more detailed description of the vectoring or queuing of incoming calls, *Ezerzer* sets forth broad limitations that anticipate the claimed subject matter of the present invention." *Borodow et al.*'s "more detailed description" however, is added matter, and is entitled only to the date of July 9, 2001, and as a result, is not available as prior art under 35 U.S.C. §102 or §103 against the instant application.

The following discussion of *Borodow* is subject to the caveat mentioned on page 22 of this paper; namely, that Applicants in presenting an analysis of the shortcomings of *Borodow*, are not admitting or conceding that *Borodow* is available as prior art against the present application.

Borodow et al. is directed to a call center administration capable of receiving calls, wherein each received call is associated with at least one priority attribute, and the call center is capable of prioritizing the received calls of the plurality of calls. [0012].

Borodow et al. states:

[0027] U.S. patent application Ser. No. 09/798,226 and U.S. patent application Ser. No. 09/638,274 describe call centers with several features. One of the features is the capability that allows provisioning configuration, and administration of a call center by non-technical employees of a company-subscriber, i.e., employees without specialized hardware or software training. This feature, referred to as self-provisioning, is made possible by a straightforward, intuitive administration manager interface that presents a call center administrator with a series of simple questions, prompts, menus, list boxes, radio buttons, and similar input means for providing information to a computer-based device.

[0028] The collection of the input means of the inventive call center administration manager in accordance with the present invention further includes a mechanism for providing a call center database with information needed for prioritizing call servicing.

[0029] **The process for inputting the information for prioritizing calls is illustrated in more detail in FIG. 1. In step 110, a call center administrator defines priority attributes relevant to prioritizing the calls, i.e., the attributes of the customer or the call used by a queuing/prioritizing algorithm. In step 120, the call center administrator provides relative weights to the call attributes defined. Next, in step 130, customer-specific values are assigned to the defined attributes. (emphasis added).**

Borodow et al. even discloses that **"to incorporate the process of defining, weighing and assigning value to caller attributes in the browser-based call center administration manager implementation described in U.S. Patent application Ser. no. 09/798,226 [Ezerzer et al.], two tabs have been added: (1) Customer Priority**

Attribute tab, and (2) Customers tab." [0033]. (emphasis added). A priority attribute may be indicative of length of time the customer has been doing business with the company, dollar amount spent within some predetermined period, frequency of transactions, kinds of products purchased or of services requests, dollar amount owed, and service level of kind of contractual relationship with the company. [0035]. The queuing of the calls is directly dependent on these call attributes. [0010, 0048, 0057] Therefore, because the queuing is directly related to these call attributes, and the ability to define and assign these call attributes was not present in *Ezerzer et al.* [0033], Applicants again affirm that these portions of *Borodow et al.* are not entitled to the parent application's filing date.

As stated in *Borodow et al.*:

[0042] FIG. 5 represents screen output of a browser-based call center administration manager interface in accordance with the present invention when **customer-specific values are being assigned to the Customer Priority Attribute objects**; this corresponds to the process step 130. To reach the screen of FIG. 4, the call center administrator right-clicks from within the Customers tab. When the screen of FIG. 5 is displayed, the administrator selects an appropriate "Find Customer" radio button 551, instructing the administration manager to search for customers by, e.g., name, telephone number, customer ID, or email address; types the search string in the box 552; and clicks on SEARCH button 557. In response to the search command, the interface interacts with the call center's database and searches for the matching customer record(s); the matching records appear in drop-box 558, with their corresponding current Customer Priority Attribute values displayed in boxes 554; Customer Priority Attribute object names appear in boxes 553. (emphasis added).

[0043] After a specific customer is identified, **new values of the customer's various Priority Attributes can be assigned or changed** in the boxes 554, and then stored by

clicking on OK button 555 or APPLY button 556. (emphasis added).

Borodow et al. further states that “the pending calls are then queued in order of their customer priority attributed based ratings; e.g., a call with a higher customer attribute-based priority rating is placed ahead of a call with a lower customer attribute-based priority rating. [0057]. Neither of the above quoted sections of *Borodow et al.*, all of which the Examiner relies on for the rejection, are disclosed in the parent application to *Ezerzer et al.*

The Examiner states on page 2 of the Office Action, that “once the customer has been identified a predetermined priority score is determined (Borodow, [0010] and the call is then queued based upon this rating, with a higher rating placing a caller ahead of a caller with a lower rating. (Borodow, [0057]). A careful review of *Ezerzer et al.* however reveals no such teaching or suggestion of this feature of *Borodow et al.*

Therefore, Applicants submit that the parts of the disclosure of *Borodow et al.* relied on by the Examiner are not disclosed in *Ezerzer et al.* and therefore constitute added matter which presumably was a reason for the filing of the CIP. As a result, those non-common parts are not entitled to the benefit of the filing date of the parent application, and are entitled only to the later CIP filing date, and therefore *Borodow et al.* is not an available reference under 35 U.S.C. § 102 and cannot be used for a 35 U.S.C. §103(a) rejection against the present application. Applicants therefore submit that the rejection of claims 1-55 under 35 U.S.C. § 103(a) as obvious under *Borodow et al.* is improper and should be withdrawn.

Regarding the claim rejections:

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection because a *prima facie* case of obviousness has not been established by the Examiner.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

I. **The Prior Art references relied on do not teach or suggest all of the claim elements**

Independent claims 1, 12, 22, 33, and 43

Independent claims 1, 22, and 43 recite, *inter alia*:

prompting the customer to provide an identification number;
retrieving, when the customer provides the identification number,
customer information about the customer based on the provided identification
number;

computing a customer prioritization score based on the
retrieved customer information; and

**prioritizing the customer inquiry based on the computed
customer prioritization score**, such that higher prioritized customer
inquiries are responded to sooner than lower prioritized customer inquiries
(emphasis added).

Independent claims 12 and 33 recite, *inter alia*:

prompting the customer to provide customer information in
response to a predetermined set of prioritization queries created to
determine the customer's likelihood to purchase an offered product;

when the customer provides customer information in response to the predetermined set of queries, **computing a customer prioritization score** based on the customer responses; and
prioritizing the customer inquiry based on the computed customer prioritization score, such that higher prioritized customer inquiries are responded to sooner than lower prioritized customer inquiries (emphasis added).

Even if *Borodow et al.* was available as prior art, the rejection should be withdrawn:

In making the arguments contained in this response, Applicants are not admitting that *Borodow et al.* is available as prior art against the present application. Even if *Borodow et al.* were available as prior art (which Applicants strenuously dispute), the reference still does not teach or suggest the features of claims 1-55. The Examiner admits on page 3 of the Office Action that *Borodow et al.* "does not expressly state where the process said ID is used." However, the Examiner goes on to allege that "[i]t is well known that supplying a customer ID at the beginning of the call eliminates errors, optimizes the call time consumption and allows for the call to be most efficiently handled. . . It would have been obvious to one having ordinary skill in the art at the time the invention was made to enhance *Borodow's* method by requesting a customer identification number at the beginning of the call in order to efficiently process the call and properly identify a customer." (Office Action, page 3)

Applicants disagree with the Examiner's allegations and conclusions as an unsubstantiated statement of questionable relevance to Applicants' claimed invention. In particular, Applicants refer the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin,

regarding “Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice.”

In relevant part, the Memorandum states, “If the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding” (Memorandum, p. 3). Further, the Memorandum indicates that the Federal Circuit has “criticized the USPTO’s reliance on ‘basic knowledge’ or ‘common sense’ to support an obviousness rejection, where there was no evidentiary support in the record for such a finding.” *Id.* at 1.

Applicants submit that “[d]eficiencies of the cited references cannot be remedied by the [Office’s] general conclusions about what is ‘basic knowledge’ or ‘common sense’.” *In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Should the Examiner maintain the rejection after considering the arguments presented herein, Applicants submit that the Examiner must provide “the explicit basis on which the Examiner regards the matter as subject to official notice and [allow Applicants] to challenge the assertion in the next reply after the Office Action in which the common knowledge statement was made” (*Id.* at 3, emphasis in original), or else withdraw the rejection.

Therefore, even if *Borodow et al.* were available as prior art (which it is not), the reference fails to teach or suggest at least “prompting the customer to provide an identification number” as recited in independent claims 1, 12, 22, 33 and 43. The Examiner has therefore not met at least one of the essential criteria for establishing a

prima facie case of obviousness; namely, that the applied reference must teach or suggest each and every one of the claim elements.

Ezerzer *et al.* also fails to teach or suggest the claim limitations:

Ezerzer et al. is directed to a network-based call center. (Abstract). A call center may be capable of identifying a calling party-customer through automatic number identification (ANI), retrieving the customer's data such as history of the customer's interactions, and routing the call to an appropriate agent based on that data. [0009]. Because information used by a call center may be sensitive and confidential, *Ezerzer et al.* states that it would be desirable to allow a subscriber to provision a call center using third-party resources while not providing the third party with a copy of the subscriber's database. [0009]. The call center scheme is to enhance security and reliability of data management in a distributed call center. [0024]. The sensitive data may include call detail data and history of customer interactions, quality control records, and credit authorizations. [0024] In the call center, this sensitive information resides in a database within the enterprise's secure zone. [0025].

To provision a call center initially, or to change its parameters at a later time, a user logs into the *Ezerzer et al.* system as an Administration Manager, and then has the choice of creating a new company object, i.e. creating a new call center object for an enterprise. [0028 and 0029]. The user can also create an agent object, for example, the object corresponding to a person. [0073] The user further has the option to create a new project, which can be one of five types, phone, predictive, chat, email and web call back. [0392].

Projects can also be given different priority levels by the administrator . [0746]. To give a priority level to the selected project, the user clicks the Priority level radio button and then selects a number (1-5) from the drop-down list to specify the priority level. The user can also set a customer priority level by selecting the custom level radio button and then filling out the remaining fields. [0751]. The custom level is configured by entering an SQL Query which will determine how the Projects are prioritized. [0752]. In the *Ezerzer et al.* system, the Administration Manger has the capability to change and edit the following characteristics relating to the system: Skills, Agents, Workgroups, QA URLs, Scripts URLs, Project Menus, Projects, Reports, and Schedules. (Figs 8-98). *Ezerzer et al.* however, does not teach or suggest at least **“computing a customer prioritization score,”** much less **“prioritizing the customer inquiry based on the computed customer prioritization score,”** such that higher prioritized customer inquiries are responded to sooner than lower prioritized customer inquiries,” as recited in claims 1, 12, 22, 33, and 44. (emphasis added).

In the Office Action, the Examiner cites to the portion in *Borodow et al.* where one may find a disclosure of “once the customer has been identified a predetermined prior score is determined (Borodow, [0010]) and the call is then queued based upon this rating.” However, the Examiner does not point to where in *Ezerzer et al.* the *Borodow* quoted teaching can also be found, and *Ezerzer et al.* - at best -states that “it is further disclosed that priority may be assigned to ‘Projects’” (Ezerzer, [0745]). (Office Action, page 6).

In the Office Action on page 3, in regard to the rejection of the claims under *Borodow et al.*, the Examiner further states “it is well known that supplying a customer

ID at the beginning of the call eliminates errors, optimizes the call time consumption and allows for the call to be most efficiently handled. It is noted that other forms of identification could be used, however an ID number is most efficient because it can be typed into the phone and is assigned to only on[e] customer, while a name or e-mail must be spoken by the caller and interpreted by an agent or computer program, and **the phone number alone is an insufficient form of identification assuming several customers could potentially call from a single line.**" (Office Action, page 3) (emphasis added). Yet, this is in direct contradiction to the Examiner's statements on page 6 of the Office Action, which states that "*Ezerzer* discloses that the call center is capable of identifying a caller 'through **automatic number identification,**' which discloses the caller's history." (emphasis added).

The Examiner acknowledges on page 3 of the Office Action, that a "**phone number alone is an insufficient form of identification**" (emphasis added), yet on page 6, seems to postulate that the "automatic number identification" feature of *Ezerzer et al.*, which merely discloses a phone number, is sufficient identification to pull up a customer's history. As a result, Applicants submit that *Ezerzer et al.* also fails to teach or suggest at least "prompting the customer to provide an identification number; retrieving, when the customer provides the identification number" as recited in independent claims 1, 12, 22, 33, and 43 because *Ezerzer et al.* at most uses "automatic number identification" and as acknowledged by the Examiner on page 3 of the Office Action, "a phone number alone is an insufficient form of identification."

The Examiner has therefore not met at least one of the essential criteria for establishing a *prima facie* case of obviousness, wherein "the prior art reference (or

references when combined) must teach or suggest all the claim limitations.” See M.P.E.P. §§ 2142, 2143, and 2143.03. Accordingly, Applicants request the Examiner to withdraw the rejection of independent claims 1, 12, 22, 33, and 43 under 35 U.S.C. §103(a) and to allow the claims. Further, Applicants request the Examiner to withdraw the rejection of dependent claims 2-7, 9-11, 14-21, 23-28, 30-32, 35-42, 44-49, and 51-55 at least in view of their dependency from allowable independent claims 1, 12, 22, 33, and 43.

Dependent claims 8, 13, 29, 34, and 50

Dependent claims 8, 29, and 50 recite, *inter alia*:

if additional customer information is needed, then the customer is prompted to respond to predefined prioritization queries created to determine the customer's likelihood to purchase an offered product

Dependent claims 13 and 34 recite, *inter alia*:

each prioritization query is created to obtain a response providing information concerning a customer's likelihood to purchase an offered product or service

Ezerzer et al. does not teach or suggest at least the above-quoted claim elements. The Examiner on page 3 of the Office Action alleges that “it is well known that generating a questionnaire for the customer to complete in order to provide personal information is an equivalent means of further enhancing a customer profile based directly upon customer response and behavior.

Again, Applicants refer the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin,

regarding "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice," and Applicants again submit that should the Examiner maintain the rejection after considering the arguments presented herein, the Examiner must provide "the explicit basis on which the Examiner regards the matter as subject to official notice and [allow Applicants] to challenge the assertion in the next reply after the Office Action in which the common knowledge statement was made" (Id. at 3), or else withdraw the rejection. In view of the above shortcomings, it is clear that the needed showing of motivation to modify a reference and reasonable expectation of success are also absent.

Therefore, *Ezerzer et al.* fails to teach or suggest at least "if additional customer information is needed, then the customer is prompted to respond to predefined prioritization queries created to determine the customer's likelihood to purchase an offered product," as recited in claims 8, 29, and 50, and also fails to teach or suggest at least "each prioritization query is created to obtain a response providing information concerning a customer's likelihood to purchase an offered product or service," as recited in claims 13 and 34. Applicants submits that dependent claims 8, 13, 29, 34, and 50 are thus allowable for the reasons stated above, in addition to their allowability as being dependent from allowable independent claims 1, 12, 22, 33, and 43. Accordingly, Applicants submit the Examiner should withdraw the 35 U.S.C. §103(a) rejection and to allow these claims.


In view of the foregoing remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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